

REMARKS

The Applicants take this opportunity to explain their reasons for filing this continuation application.

The parent application of this continuation application is U.S. Patent Application No. 10/254,698, filed on September 24, 2002, for "SUBBAND ACOUSTIC FEEDBACK CANCELLATION IN HEARING AIDS". In the parent application the Examiner issued an office action mailed April 8, 2003 in which the Examiner required the Applicants to restrict the application based on the figures of the application. The Applicants believe that the restriction requirement was not proper for a variety of reasons which will be explained below. Accordingly the Applicants have filed the present application and request the Examiner not to issue a restriction requirement in this application based on the figures. Rather, if the Examiner desires to issue a restriction requirement the Examiner is requested to base the restriction requirement on the claims, as will be explained below.

In the parent application the Examiner's restriction requirement stated as follows:

"The application contains claims directed to the following patentably distinct species of the claimed invention: The different species are as follows: Figures 5-7, Figure 8, Figure 10, Figure 11, Figure 12, and Figures 13-15. Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claims is finally held to be allowable. Currently, no generic."

This "restriction requirement" was improper for at least the following reasons.

I. THE LAW REQUIRES THAT A RESTRICTION REQUIREMENT BE BASED ON CLAIMS, NOT ON FIGURES.

The statutory basis for restriction requirements refers to **claims**, not figures. “If two or more independent and distinct inventions are **claimed** in one application, the Director may require the application to be restricted to one of the inventions.” 35 USC §121 (emphasis added.)

The Manual of Patent Examining Procedure (MPEP) does not allow the restriction requirement imposed by the Examiner in the parent case. The MPEP requires that an Examiner must base a restriction requirement on the **claims**, not the figures in an application.

The MPEP clearly requires an Examiner to base a restriction on the **claims**. There are many examples of this throughout Chapter 800, which governs restriction practice, and some of the most prominent are recited below.

“In passing upon questions of double patenting and restriction, it is the **claimed** subject matter that is considered and such **claimed** subject matter must be compared in order to determine the question of distinctness and independence.” MPEP § 806.01.

“Where the **claims** of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required.” MPEP § 806.03.

“Where an applicant files a divisional application claiming species **claimed** but not elected in the parent case . . . there should be no determination of whether or not the species **claimed** in the divisional is patentable over the species retained in the parent case since that determination was made before the requirement to restrict was made. . . . “[T]he Examiner should not require restriction to a reasonable number of species unless he or she is satisfied that he or she would be prepared to allow **claims** to each of the **claimed** species over the parent case, if presented in a divisional application. . .” MPEP § 806.04(h).

The form Outline of Letter for Restriction requires the Examiner to, "List **claims** in each group." MPEP § 817 Outline of Letter (a)(2).

II. IN THE PRESENT APPLICATION RESTRICTION BASED ON THE FIGURES IS INAPPROPRIATE.

In the present application independent claim 23 is generic. Claim 23 reads on at least the embodiments illustrated in the following Figures: 5, 7, 8, 10 and 12. Similarly, independent Claim 2 is generic, and Claim 2 reads on at least the embodiments illustrated in the following Figures: 5, 7, and 8. Accordingly, to restrict the application to any one of Figures 5, 7, 8, 10, or 12 would not make any sense.

If the Examiner chooses to issue a restriction requirement, the Applicants request that the restriction be to Species 1: Claims 2-11 and 23, Species 2: Claims 12-16, Species 3: Claims 17-21, or Species 4: Claim 22.

Request for Allowance

In view of the foregoing, consideration and an early allowance of this application are earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below. The Commissioner is hereby authorized to charge any additional fees or


Appl. No.: 10/737,206
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credit any overpayment to Deposit Account No. 50-1698.

Respectfully submitted,
THELEN REID & PRIEST LLP

Dated: January 30, 2004



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